

| | | | |
|------------------------------|--------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 10/777,588 | Applicant(s) ITKIS ET AL. | |
| | Examiner MATTHEW D. HOEL | Art Unit 3714 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/12/2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 57-79 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 57-79 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

2. A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

4. Determining the scope and contents of the prior art.
5. Ascertaining the differences between the prior art and the claims at issue.
6. Resolving the level of ordinary skill in the pertinent art.
7. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 57 to 61, 63, 64, and 66 to 79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Franchi (U.S. patent 5,770,533 A) in view of Gimmon (U.S. patent 5,096,195 A) and further in view of Paulsen, et al. (U.S. patent 6,712,698 B2).

9. As to Claim 57: '533 discloses all of the elements of Claim 1, but lacks specificity as to the gaming device receiving data via a first two-way communication channel from the computer while being housed in the dispenser with the first communication channel being secure. Franchi teaches in '533 a self-service dispenser for dispensing at least one portable gaming device with the dispenser being controlled by a computer and the computer operationally interfaced with a first transceiver (Col. 15, Lines 38 to 54; Col.

Art Unit: 3714

16, Lines 18 to 22). The data enables operation of the gaming device following the dispensing of the gaming device from the dispenser, with the portable gaming device including a second transceiver and being in wireless communication with the computer via a second two-way communication channel comprising a first and second transceiver (Col. 15, Lines 26 to 37). '195, however, teaches the gaming device receiving data via a first two-way communication channel from the computer while being housed in the dispenser, with the first communication channel being secure (authorizes gaming unit, Fig. 6; Col. 6, Line 46 to Col. 7, Line 2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the hardwired two-way communication channel of '195 to the dispenser of '533. Both inventions are dispensers that dispense multiple portable gaming units to customers on a rental basis. The authorization scheme of '195 shown in Fig. 6 could be used to protect the customer accounts detailed in '533 (Col. 6, Lines 30 to 36). The advantage of this combination is that the hard-wired communication while the portable game is in the dispenser would be more secure than the wireless communication used while the game is out of the dispenser. Regarding the new limitation of the multiple portable devices, Col. 15, Lines 55 to 65 of '533 teaches multiple RSATs (portable gaming devices). Alternatively, this is obvious in light of *in re Harza* MPEP 2144.04(VI)(B) as it is merely a duplication of parts without adding increased functionality, as it is already known in the art that games like poker and blackjack taught by '533 (3:38-47) have multiple players: "*in re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960) (Claims at issue were directed to a water-tight masonry structure wherein a water seal of flexible material fills the joints which

Art Unit: 3714

form between adjacent pours of concrete. The claimed water seal has a “web” which lies ** in the joint, and a plurality of “ribs” ** >projecting outwardly from each side of the web into one of the adjacent concrete slabs. <The prior art disclosed a flexible water stop for preventing passage of water between masses of concrete in the shape of a plus sign (+). Although the reference did not disclose a plurality of ribs, the court held that mere duplication of parts has no patentable significance unless a new and unexpected result is produced.)” See, for example, “Scarne’s Encyclopedia of Card Games,” by John Scarne, 1973 HarperCollins, chapters on poker and blackjack for multiple players. Regarding the new limitations of the portable gaming devices being each in communication with one or more designated portable gaming devices also functioning as cashier devices, this also would have been obvious to one of ordinary skill in the art at the time the invention was made. ‘698 teaches the portable gaming devices being each in communication with one or more designated portable gaming devices also functioning as cashier devices (22:52-67). This would have been obvious as ‘533 teaches a “see cashier” feature in which a player can call a cashier (309, 6:15), the player is able to call for service (8:27-28), and remotely bet “over the shoulder” at crowded table games (19:14-21) which would require the player to be able to make a bet without directly interfacing with the gaming table. Such a feature would allow a player to reconcile his or her bets remotely in a similar manner as ‘533’s local reconciliation at the gaming table’s RSAT interface (15:49-54). Providing a feature in which the player’s portable unit is able to communicate directly with the cashier’s portable unit would have the effect and advantage of allowing the players to make

Art Unit: 3714

multiple, repeated wagers from anywhere in the casino without having to return to the gaming table's RSAT interface every time the player wanted to bet again or to bet on a different kind of game.

10. As to Claim 58: '533 includes a latch for securing the gaming device in the dispenser, with the latch being released upon a predetermined event (physically releases RSAT, latching mechanism inherent, Col. 15, Lines 38 to 44).

11. As to Claim 59: The predetermined event that releases the latch in '533 is the insertion of monetary consideration into the dispenser (Col. 15, Lines 44 to 47).

12. As to Claim 60: In '533 the dispenser receives from the gaming device an identification of the gaming device when the gaming device is housed in the dispenser (RSAT necessarily identifies itself when returned, Col. 16, Lines 14 to 17). Regarding the new limitation of the multiple portable devices, Col. 15, Lines 55 to 65 of '533 teaches multiple RSATs (portable gaming devices).

13. As to Claim 61: The data in '533 can be a bingo card (Col. 8, Lines 35 to 38).

14. As to Claim 63: In '533 the portable gaming device includes a transceiver for wireless communication with the computer while being outside of the dispenser.

Regarding the new limitation of the multiple portable devices, Col. 15, Lines 55 to 65 of '533 teaches multiple RSATs (portable gaming devices).

15. As to Claim 64: The dispenser of '195 charges a gaming device battery while the gaming device is housed in the dispenser. Regarding the new limitation of the multiple portable devices, Col. 15, Lines 55 to 65 of '533 teaches multiple RSATs (portable gaming devices).

Art Unit: 3714

16. As to Claim 66: The dispenser of '533 includes a card reader for reading a player club card (Col. 15, Lines 38 to 54).

17. As to Claim 67: '195's dispenser includes a printer for printing a sales receipt (121, Fig. 8).

18. As to Claim 68: The dispenser of '533 includes a barcode reader for reading barcodes (Col. 10, Lines 32 to 34). Regarding the new limitation of the multiple portable devices, Col. 15, Lines 55 to 65 of '533 teaches multiple RSATs (portable gaming devices).

19. As to Claim 69: The dispenser of '533 maintains an account for at least one user of a gaming device (Col. 6, Lines 30 to 36).

20. As to Claims 70 and 71: '533 is capable of crediting the players account upon return of the gaming device to the dispenser and refunding the balance of the account upon return of the gaming device to the dispenser (Col. 6, Lines 30 to 36; Col. 15, Lines 49 to 54). Regarding the new limitation of the multiple portable devices, Col. 15, Lines 55 to 65 of '533 teaches multiple RSATs (portable gaming devices).

21. As to Claim 72: The RSAT of '533 can communicate with the computer by infrared communication (Col. 16, Lines 18 to 22).

22. As to Claims 73 to 79: '533 teaches a self-service dispenser for dispensing at least one portable gaming device (Col. 15, Lines 38 to 54). The dispenser of '195 is controlled by a computer (Fig. 3). The dispenser includes a latch for securing the gaming device in the dispenser, with the latch being controlled by the computer and released upon a predetermined event ('533, dispenser reads player card and releases

Art Unit: 3714

RSAT upon sufficient player balance, Col. 15, Lines 38 to 54). The gaming device is able to receive data while housed in the dispenser ('195, Col. 6, Line 46 to Col. 7, Line 2). Data enables operation of the portable gaming device following dispensing from the dispenser ('533, Col. 15, Lines 26 to 37, Col. 15, Line 66 to Col. 16, Line 13). '533 releases the portable gaming device upon insertion of monetary consideration (Col. 15, Lines 38 to 54). '195 teaches a bill validator (Para. 4, Claim 1). '533 teaches a barcode reader (Col. 10, Lines 32 to 34). '533 teaches a magnetic card reader (Col. 2, Lines 51 to 54; Col. 15, Lines 38 to 55). In light of the fact that in '533 winnings and losses are credited to the player and the player's card is released upon return of the RSAT (Col. 15, Lines 38 to 55) and '640 teaches bonus awards, it would be an obvious design choice to return a deposit to a player or award bonus points as an incentive for returning the portable gaming device. Regarding the new limitation of the multiple portable devices, Col. 15, Lines 55 to 65 of '533 teaches multiple RSATs (portable gaming devices). Alternatively, this is obvious in light of in re Harza MPEP 2144.04(VI)(B) as it is merely a duplication of parts without adding increased functionality, as it is already known in the art that games like poker and blackjack taught by '533 (3:38-47) have multiple players: "In re Harza, 274 F.2d 669, 124 USPQ 378 (CCPA 1960) (Claims at issue were directed to a water-tight masonry structure wherein a water seal of flexible material fills the joints which form between adjacent pours of concrete. The claimed water seal has a "web" which lies ** in the joint, and a plurality of "ribs" ** >projecting outwardly from each side of the web into one of the adjacent concrete slabs. <The prior art disclosed a flexible water stop for preventing passage of water between masses of

Art Unit: 3714

concrete in the shape of a plus sign (+). Although the reference did not disclose a plurality of ribs, the court held that mere duplication of parts has no patentable significance unless a new and unexpected result is produced.)” See, for example, “Scarne’s Encyclopedia of Card Games,” by John Scarne, 1973 HarperCollins, chapters on poker and blackjack for multiple players. Regarding the new limitations of the portable gaming devices being each in communication with one or more designated portable gaming devices also functioning as cashier devices, this also would have been obvious to one of ordinary skill in the art at the time the invention was made. ‘698 teaches the portable gaming devices being each in communication with one or more designated portable gaming devices also functioning as cashier devices (22:52-67). This would have been obvious as ‘533 teaches a “see cashier” feature in which a player can call a cashier (309, 6:15), the player is able to call for service (8:27-28), and remotely bet “over the shoulder” at crowded table games (19:14-21) which would require the player to be able to make a bet without directly interfacing with the gaming table. Such a feature would allow a player to reconcile his or her bets remotely in a similar manner as ‘533’s local reconciliation at the gaming table’s RSAT interface (15:49-54). Providing a feature in which the player’s portable unit is able to communicate directly with the cashier’s portable unit would have the effect and advantage of allowing the players to make multiple, repeated wagers from anywhere in the casino without having to return to the gaming table’s RSAT interface every time the player wanted to bet again or to bet on a different kind of game.

Art Unit: 3714

23. Claim 62 is rejected under 35 U.S.C. 103(a) as being unpatentable over '533, '195, and '698 in view of Walker, et al. (U.S. patent 6,024,640 A).

24. As to Claim 62: The combination of '533, '195, '698 discloses all of the elements of Claim 62, but lacks specificity as to the data including an encryption key. '640, however, teaches a portable wireless gaming device that uses encrypted communication (146, 148, and 150, Fig. 6). It would have been obvious to one of ordinary skill in the art to apply the wireless encryption of '640 to the combination of '533, '195, and '698. '195 in Fig. 6 checks the identity of the gaming device, which would ideally be done through encryption. '533 can be used for lottery applications (Col. 8, Lines 35 to 38), like '640. The advantage of this combination would be to further secure the gaming system communications.

25. Claim 65 is rejected under 35 U.S.C. 103(a) as being unpatentable over '533, '195, and '698 in view of Rocco, et al. (U.S. pre-grant publication 2001/0035425 A1).

26. As to Claim 65: The combination of '533, '195, and '698 discloses all of the elements of Claim 65, but lacks specificity as to a bill validator for accepting monetary consideration in return for the gaming device. '425, however, teaches a bill acceptor for the dispensing of electronic handheld communication devices (Para. 4, Claim 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have applied the bill validator of '425 to the combination of '533, '195, and '698. The invention of '195 dispenses portable wireless electronic devices like '533. '533 teaches a cash slot at a blackjack table (Fig. 7) and dispensers at gaming tables (Col.

Art Unit: 3714

15, Lines 55 to 65). The advantage of this combination would be to automate the cash collection process of '533 by having it done by the dispenser. Regarding the new limitation of the multiple portable devices, Col. 15, Lines 55 to 65 of '533 teaches multiple RSATs (portable gaming devices).

Response to Arguments

27. Applicant's arguments filed 11-12-2007 have been fully considered but they are not persuasive. The examiner's "Response to Arguments" of 9-21-2006 and 5-11-2007 are incorporated by reference. Regarding Page 2 of the Remarks, the applicants state that there is no motivation for the employees to carry wireless cashier devices because of potential for cheating. "Employees having mobile cashiering capabilities can collude with players having mobile player units by hiding in places without surveillance equipment (e.g., restrooms, closets, areas off the casino floor, etc.) to conduct illicit activities that cannot be readily monitored." These capabilities are not disclosed in Franchi or Gimmon. Nearly all network activity is logged and audited. Franchi, for example, teaches that play is monitored to accurately determine winnings and losses for the hosue (5:40-48). Franchi also disconnects the link between the central computer and the individual game computer once the player's balance has been verified (6:37-45) to prevent corrupt employees and hackers from altering game play. Franchi also teaches scrambling communications to defeat any hacking attempts (6:45-52). Franchi's chips have identification electronically embedded into them to prevent counterfeiting (11:43-64). '698 teaches biometric input devices (cameras, retinal

scanners, fingerprint readers, 20:18-40; and voice recognition, 22:26-42). These security measures would serve to prevent the collusion hypothesized by the applicants. The cashier functions claimed by the applicants are not developed in the claims. The cashier functions explicitly claimed by the applicants are actually done by the dispenser, such as reading player cards, accepting cash, and printing receipts. The RSAT or dispensed gaming device of Franchi ('533) carries out cashier functions (15:40-54, 16:1-13, 18:6:10, 18:14-20, 18:37-42), while '698 explicitly calls a casino employee to carry out a cashier function (wireless device of player calls wireless device of casino employee for point of play registration, 22:52-67). The examiner respectfully disagrees with the applicants as to the claims' condition for allowance.

Conclusion

28. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

29. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 3714

30. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW D. HOEL whose telephone number is (571)272-5961. The examiner can normally be reached on Mon. to Fri., 8:00 A.M. to 4:30 P.M.

31. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E. Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

32. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Matthew D. Hoel
Patent Examiner
AU 3714

Robert E. Pezzuto
Supervisory Patent Examiner
Art Unit 3714